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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/083,422	05/22/1998	SCOTT CLARE	016325-00221	3984

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TIMOTHY S. CORDER  
VINSON & ELKINS LLP  
2300 FIRST CITY TOWER  
1001 FANNIN STREET  
HOUSTON, TX 77002-6760

EXAMINER

PEDDER, DENNIS H

ART UNIT	PAPER NUMBER
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3612

DATE MAILED: 02/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/083,422**

Applicant(s)  
**Clare et al.**

Examiner  
**Dennis H. Pedder**

Art Unit  
**3612**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 17, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 49-89, 91-94, and 96-127 is/are pending in the application.
- 4a) Of the above, claim(s) 1 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 94, 96, 97, 126, and 127 is/are allowed.
- 6) ☒ Claim(s) 49-56, 58-73, 75-86, 88, 89, 91-93, and 98-125 is/are rejected.
- 7) ☒ Claim(s) 57, 74, and 87 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on May 22, 1998 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3935
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 103, 107 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This application appears to have no support as filed for these claimed terms. If applicant traverses, specific page and line numbers and figure locations should be pointed out.

103  
210

107  
615

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 86, 100, 110, 114, 115, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 86 is vague. There is no disclosed panel that has optional vertical or horizontal hinging. --one of-- is apparently intended. *still*

Applicant's use of the term "sports utility vehicle" in the claims is indefinite as the precise meaning of such appears to be a cultural phenomena, not an art specific term. In addition, the meaning could change over the life of any patent to issue. Further any vehicle can be used for sports and utility. *still*

### ***Drawings***

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the storage area less than and equal to the width of the wheel well, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. *still*

### **Claim Format**

6. Applicant is notified that the use of claims of the scope of some of the claims in this application together with the sheer volume of same may have consequences not intended by applicant, for example, not only extending the prosecution of the application but also tending to obscure the invention, resulting in numerous newly presented references applied against the

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claims. The examination process is, like the judicial process, a search for truth, a valid patent, but such a search is tedious and difficult when dealing with claims 49-127 of an original 127 claims.

*Specification*

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the width of the storage area is less than or equal to the width of the wheel or well.

*Election/Restriction*

8. Claim 1 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected species. Election was made **without** traverse in Paper No. 33.

Claim 1 is still present in this application. As applicant's election was to claims 49-89, 91-94, and 96-97 in paper no. 33, claim 1 is withdrawn. Oversight of the listing of this matter is regretted.

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***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 61, 62, 64-65, 109-110, ~~112~~ are rejected under 35 U.S.C. 102(b) as being anticipated by Perlman et al..

Perlman et al. have forward cab and enclosure defined by the bed 12, 14, 16, and rear door 22. The members 12, 14 bound the enclosure at sides and have side panels 108. Perlman et al. have a storage area 100 extending into the enclosure at least inwardly of the side panels 108, which are contoured as seen in figure 1. Perlman et al. have hinged sections 40, 50, and 130 opening into the compartment storage area from the exterior.

As to claims 110, 112, the vehicle of Perlman et al. is usable for sports and utility.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 63 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. in view of Payne et al..

It would have been obvious to one of ordinary skill in the art to provide in Perlman et al. a bed width aligned with the cab width as taught by Payne et al. in order to prevent inadvertent contact with the bed. This is merely a matter of size, not a patentable distinction.

13. Claims 66-70, 72, 114-119, 123, 124 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. in view of Holan et al..

It would have been obvious to one of ordinary skill in the art to provide in Perlman et al. multiple hinged sections as taught by Holan et al. on the vehicle in order to store additional items. This is merely an obvious duplication of parts.

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As to claim 114, Holan et al. teach that the storage area is adjacent a wheel well.

As to claims 115-117, the vehicle of Perlman et al. and Holan et al. are utility and sports vehicles and that of the latter is a van.

As to claim 123, key locks are common knowledge in the art.

As to claim 124, Holan et al. teach a shelf.

14. Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. in view of Holan et al. as applied to claim 68 above, and further in view of Douglass, Jr..

It would have been obvious to one of ordinary skill in the art to provide in the references above an extended hinged section as taught by Douglass, Jr. in order to store large items.

15. Claim 73 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. in view of Holan et al. as applied to claim 61 above and further in view of McGloughlin.

It would have been obvious to one of ordinary skill in the art to provide in the references a strut as taught by McGloughlin in order to strengthen the opened shelf 138/side panel.

16. Claims 49-50, 53, 54, 55, 58, 60, 98-103, 106-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holan et al. in view of Perlman et al..

Holan et al. lacks merely the bowed side panels, a detail known in this art prior to the invention of applicant as evidenced by Perlman et al.. It would have been obvious to one of



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ordinary skill in the art to provide in Holan et al. bowed side panels as taught by Perlman et al. in order to increase the storage capacity as well as the strength of the panel.

As to claims 53-54, Holan et al. teaches an enclosed storage area and Perlman et al. has the claimed latch members.

As to claims 100-102, in addition to the comments above, application of the teachings of Holan et al. and Perlman et al. to any current production vehicle are deemed to be an obvious expedient to one of ordinary skill in the art.

Claim 103 cannot be fully evaluated, but the hinge of Perlman et al. extends inwardly of the outer side.

As to claim 106, the wall 104 is a side of the cargo area of Perlman et al..

As to claim 107, the size of the storage area is not an indicator of patentability, but an obvious expedient to one of ordinary skill in the art.

As to claim 108, vehicles are manufactured on assembly lines as a matter of common knowledge.

17. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holan et al. in view of Perlman et al. as applied to claim 49 above, and further in view of McGloughlin.

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It would have been obvious to one of ordinary skill in the art to provide in the references above a strut assembly 21 as taught by McGloughlin in order to better support the opened section.

18. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holan et al. in view of Perlman et al. as applied to claim 49 above, and further in view of Gallagher et al..

It would have been obvious to one of ordinary skill in the art to provide in the references above a drain/vent valve as taught by Gallagher et al. in order to drain liquids and vent moisture from the storage compartments.

19. Claim 85-86, 89, 91, 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. in view of Lewellen et al., Design 364,591, and McGloughlin.

Perlman et al. lacks a teaching of the width of the wheel well/storage area a detail known in this art as evidenced by Lewellen et al. in figure 3, and a strut for the side panel section, using instead a cable, another known detail in this art as evidenced by McGloughlin at 21. It would have been obvious to one of ordinary skill in the art to provide in Perlman et al. a storage compartment sized as taught by Lewellen et al. in order to accommodate other cargo in the enclosure and a strut as a rigid support for the movable side panel as taught by McGloughlin for better support.

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As to claim 91, passengers may be carried in any compartment, and although not claimed, Lewellen et al. teaches an enclosed compartment.

20. Claim 88 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. in view of Lewellen et al. and McGloughlin as applied to claim 85 above, and further in view of Gallagher et al..

It would have been obvious to one of ordinary skill in the art to provide in the references above a drain/vent valve as taught by Gallagher et al. in order to drain liquids and vent moisture from the storage compartments.

21. Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holan et al. in view of Perlman et al. as applied to claim 49 above, and further in view of Payne et al..

It would have been obvious to one of ordinary skill in the art to provide in the references above an aligned bed and cab as taught by Payne et al. in order to avoid inadvertent contact.

22. Claim 125 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lewellen et al.. in view of Holan et al..

It would have been obvious to one of ordinary skill in the art to provide in Lewellen et al. a storage area behind the movable side doors as taught by Holan et al. in order to store equipment in a convenient location. All storage area details are taught by Holan et al. and the claimed width of the storage area is evidenced by Lewellen et al. in figure 3.

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23. Claims 51,52, 105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holan et al. in view of Perlman et al. as applied to claim 49 above, and further in view of Douglass, Jr..

It would have been obvious to one of ordinary skill in the art to provide in the references above a storage area extending along a substantial portion of the side panel as taught by Douglass, Jr. in order to store large items.

As to claim 105, the storage area of Douglass, Jr. is commensurate with the wheel well area as seen in figure 5 and 3, the exact size being an obvious expedient to one of ordinary skill in the art.

24. Claims 104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holan et al. in view of Perlman et al. and further in view of Lewellen et al..

It would have been obvious to one of ordinary skill in the art to provide in the references above a storage area of less width than the wheel well (and wheel) area as taught by Lewellen et al. in figure 3.

25. Claims 110-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al..

Application of the teachings of Perlman et al. to any currently manufactured vehicle is deemed to be an obvious expedient to one of ordinary skill in the art.

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26. Claims 120-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. in view of Holan et al. as applied to claim 114 above, and further in view of Ward.

It would have been obvious to one of ordinary skill in the art to provide in the references above a hidden lock as taught by Ward in order to deter thieves.

As to claims 122, the lock of ward is electrical.

As to claim 121, cable actuated locks are common knowledge in the art.

*Allowable Subject Matter*

27. Claims 94, 96, 97, 126, 127 are allowed.

28. Claims 57, 74, 87 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

29. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

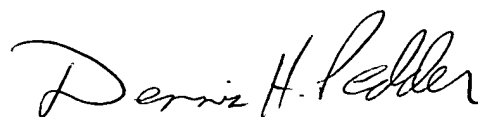
***Information Disclosure Statement***

30. The IDS of 4/30/2001 is completed and a copy attached. The IDS of 12/17/2001 is completed as to the references of record. Lined out references are either not received or duplicated on the IDS of 4/30/2001.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Pedder whose telephone number is (703)308-2178. Fax amendments to expedite handling should be sent to (703) 305-7687.

DHP

January 31, 2002



Dennis H. Pedder

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Primary Examiner  
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1/31/02